

REMARKS

This application has been carefully reviewed in light of the Office Action dated December 22, 2003 (Paper No. 30). Claims 39 to 50, 52 and 53 are presented for examination, of which Claims 39, 45, 52 and 53 are independent claims. Reconsideration and further examination are respectfully requested.

Initially, the Office Action indicated that Claims 51 and 54 were withdrawn from consideration as allegedly being directed to a non-elected invention. In this regard, Claims 51 and 54 have been cancelled.

Claims 39 to 50, 52 and 53 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to meet the written description requirement; and Claims 39 to 50, 52 and 53 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.

As to the § 112, first paragraph rejection, independent Claims 39, 45, 52 and 53 have been amended to recite that a user is informed that the image forming apparatus is under download or update of control codes by the rewrite execution codes, instead of display copying settings. Support for this amendment can be found at least at page 15, lines 6-12, page 22, line 25 to page 23, line 7, and Figure 6. It is believed that Claims 39 to 50, 52 and 53 meet the requirements of 35 U.S.C. § 112, first paragraph. The claim amendments described above are also believed to clarify the claim so as to meet the requirement of 35 U.S.C. § 112, second paragraph. As such, withdrawal of the 35 U.S.C. § 112 rejections is respectfully requested.

Claims 39 to 50, 52 and 53 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,787,288 (Nagata) in view of U.S. Patent No. 6,341,373 (Shaw), and alternatively under 35 U.S.C. § 103(a) over Shaw in view of Nagata. Claims 39 to 50, 52 and 53 were also rejected under 35 U.S.C. § 103(a) over Nagata in view of U.S. Patent No. 6,134,711 (Nakamura) and/or JP 8-212079 (Senma) and further in view of Shaw, and alternatively under 35 U.S.C. § 103(a) over Shaw in view of Nagata and further in view of Nakamura and/or Senma. Additionally, Claims 39 to 50, 52 and 53 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,987,535 (Knodt) and U.S. Patent No. 5,590,373 (Whitley) in combination with rejections over Nagata, Shaw, Nakamura and Senma. Reconsideration and withdrawal of the rejections are respectfully requested.

Among the features recited in amended independent Claims 39, 45, 52 and 53, each of these claims includes the feature of informing a user of the fact that the image forming apparatus is under download or update of control codes by the rewrite execution codes, instead of displaying copying settings. The applied references are not understood to disclose or suggest at least this feature of the present invention.

Nagata relates to a method and device for renewing an internal program of an apparatus having communication capability. The Office Action concedes that Nagata fails to teach that copying settings are not displayed during execution of the rewrite execution codes. However, the Office Action argues that it would have obvious to one of ordinary skill in the art to incorporate such a limitation into Nagata. Applicants respectfully disagree. The Office Action's position is wholly unsupported by any references to prior art and amounts to impermissible hindsight based on Applicants' disclosure.

Under a different rejection, the Office Action contends that Nakamura and Senma teach the feature that copying settings are not displayed during execution of the rewrite execution codes. However, Nakamura merely teaches that the message “under upgrading” is displayed when upgrade data is detected and sent. Nakamura is not seen to teach that the message is displayed instead of copying settings, as Nakamura makes no reference to copying settings, or any other settings that may be displayed instead.

The Office Action further contends that Senma teaches displaying only information related to a downloading operation on an image forming device. However, Senma is seen to merely state that a downloading execution information display means C displays the information on the downloading operation on a control panel B (see English abstract). Senma is not seen to teach or suggest, as argued by the Office Action, that only information related to downloading is displayed. Furthermore, Senma is not seen to teach or suggest that such information is displayed instead of copying settings.

As such, Nagata in combination with Nakamura and Senma is not seen to disclose or suggest at least the feature of informing a user of the fact that the image forming apparatus is under download or update of control codes by the rewrite execution codes, instead of displaying copying settings.

The other applied references, namely Shaw, Knodt and Whitley, are not understood to disclose or suggest anything to remedy the foregoing deficiencies of Nagata, Nakamura and Senma. Accordingly, amended independent Claims 39, 45, 52 and 53 are believed to be allowable over the applied references.

The other claims in the application are each dependent from the independent claims and are believed to be allowable over the applied references for at least the same reasons. Because each dependent claim is deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merits is respectfully requested.

The 35 U.S.C. § 103(a) rejection over Knodt and Whitley in combination with rejections over Nagata, Shaw, Nakamura and Senma has not been directly addressed. The Office Action failed to state reasons for the rejection together with such information and references as may be useful, as required by 35 U.S.C. § 132, and as such, Applicants lack the wherewithal to respond to the rejection. If the Patent Office persists in maintaining this rejection, information must be provided that shows how the above-mentioned references apply to the present invention's claims.

No other matters being raised, it is believed that the entire application is fully in condition for allowance, and such action is courteously solicited.

Applicants' undersigned attorney may be reached in our Costa Mesa,
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Respectfully submitted,


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